

In re Patent Application of  
Gardner

Serial No. 10/044,738

REMARKS

Applicant thanks the Examiner for the thorough examination of the present application. Applicant also thanks the Examiner for the indication that Claims 26-35 are allowed (paragraph 7 of final Official Action), the indication that Claim 13 would be allowed if rewritten in independent form (paragraph 6 of final Official Action), and the indication carried over from the prior Office Action that Claims 14-25 would be allowed if the 35 U.S.C. § 112 concerns (paragraph 1 of final Official Action and paragraphs 6-7 of previous Official Action) are addressed. Accordingly, Applicant has amended Claim 14 to address the 35 U.S.C. § 112, and Claims 14-25 should now be in a condition for allowance. Also, Applicant has added new Claim 36 which is a combination of original Claim 1 and original Claim 13 as indicated as being allowable by the Examiner. As such, Claim 36 should be in a condition for allowance as well. As also applicable in Applicant's previous response to the previous Official Action, these amendments to the claims, including new Claim 36, in response to this final Official Action are made without prejudice as to patentability, limitations in the art, and equivalents.

In the final Official Action, the Examiner rejected Claim 1, 3-5 and 7-12 under 35 U.S.C. § 103(a) as being unpatentable over Nagle et al. '028 in view of Nilson et al. '144 "for the reasons as set forth in the previous office action." The Examiner also rejected Claim 2 under 35 U.S.C. § 103(a) as being unpatentable over Nagle et al. '028 in view of Nilsson et al. '144 as applied to Claims 1, 3-5 and 7-12 above, and further in view of Behrendt et al. '922 with no explanation. The Examiner additionally rejected Claim 6 under 35 U.S.C. § 103(a) as being unpatentable over Nagle et al. '028 in view of Nilsson et al. '144 as applied to Claims 1, 3-5, and 7-12 above, and further in view of Environment Conscious Ceramics (Ecoceramics) by Singh (hereinafter "Singh") with no explanation.

Applicant, however, respectfully submits that the Examiner's rejection is not properly explained as required by the MPEP, and, therefore, the final status of this Official Action should be removed. For example, the Examiner rejected Claims 1, 3-5, and 7-12 "for the reasons as set forth in the previous office action." This is improper where Applicant made substantive amendments to at least Claims 2, 4-6, and 10-11. In other words, where these claims have been

In re Patent Application of  
Gardner

Serial No. 10/044,738

substantively amended, simply lumping them in with a rejection for reasons stated in a previous office action provides no basis for rejection of these claims. How can these be rejected for the same reasons when the claims were not the same as the claims, which were rejected in the previous office action? Clearly, this is impermissible. Also, with respect to Claims 2 and 6, no explanation has been provided as to why these patent documents form the basis of the rejection, especially where new amendments had previously been made. This, likewise, is impermissible as suggested in the MPEP and is impermissible to make a proper *prima facie* rejection under 35 U.S.C. § 103. Accordingly, the MPEP § 706.02(j) sets forth that “[a]fter indicating that the rejection under 35 U.S.C. § 103, the examiner should set forth in the Office action:

- (A) the relevant teachings in the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate.
  - (B) the difference or differences in the claim over the applied reference(s),
  - (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and
  - (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.” (Emphasis added).

For example, none of this has been done with respect to Claims 2 and 6 at a minimum, as well as Claims 4-5 and 10-11 where other substantive amendments took place as well. Claim 5, for example, sets forth that "a vacuum is applied to substantially surround the perform prior to the step of heating the perform under pressure in the autoclave," and the Examiner has not even addressed or acknowledged this additional step. This alone makes the "final" status of this Official Action improper. Also, with respect to Claims 2, 4-6, and 10-11 (where other substantive amendments had been made), this same section of the MPEP sets forth that "[i]t is important for an examiner to properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply." Because at least Claims 2 and 6 had been amended previously, simply citing these references does not communicate any basis for which issues can be identified by Applicant. The same is true at least for Claims 4-5 and 10-11. Further, nothing in the communication from the Examiner with

In re Patent Application of  
Gardner

Serial No. 10/044,738

respect to at least these claims sets forth a proper prima facie showing of obviousness as required, e.g., no line of reasoning, no cites to column or page number, no differences explained, no proposed modification, and no explanation or evidence of motivation to combine patent documents. Finally, nothing in the final Official Action indicates that any further searching was conducted on these amendments to the claims. Therefore, for at least this reason, Applicant respectfully submits that the final status of this Official Action is improper and should be withdrawn.

Also, Applicant respectfully submits that even the previous Official Action did not "reference to the relevant column or page number(s) and line number(s) where appropriate" as suggested by the MPEP. Clearly, the Nagle et al. '028 patent is a lengthy patent document and without some communication from the Examiner onto what is relied upon makes an appropriate response difficult and does not "properly communicate the basis for a rejection so that the issues can be identified early and the applicant can be given fair opportunity to reply" as required by the MPEP. As an example of this, the Examiner continuously in the final Official Action sets forth in paragraph 8 that "[t]he examiner did not state that these are the exact claimed limitations" or "the examiner has not mischaracterized the claims" when the Applicant has argued its interpretation of what the Examiner has stated in the previous Official Action. What makes this confusing for the Applicant is that there is no column number, line number, or even section referenced in the Examiner's previous Official Action for which Applicant can try to follow the Examiner's reasoning. Any opportunity for misunderstanding and mischaracterization can be significantly reduced, if the communication is clear and where the basis of the rejection is referenced. Otherwise, as appears to have occurred in this instance, and with all respect to the Examiner, Applicant has not had a fair opportunity to respond prior to a final action issuance. Therefore, for at least this reason, Applicant respectfully submits that the final status of this Official Action is improper and should be withdrawn.

Additionally, Applicant respectfully submits that in the final Official Action, in paragraph 8, the Examiner now for the first time attempts to clarify what was being stated in the previous Official Action. Because this clarification is even needed, should provide the Examiner with enough evidence to indicate that a final Official Action is not warranted under these circumstances. For example, in remarks related to rejections of Claims 1, 3-5, and 7-12, the

In re Patent Application of  
Gardner

Serial No. 10/044,738

Examiner references language from a claim, namely Claim 13, which was not rejected and was not part of the basis for the remarks. How is Applicant to understand that this is basis where the Examiner is somehow finding support for an argument related to Claims 1, 3-5, and 7-12 absent a clear delineation of the Examiner's position? Instead, Applicant should be able to properly address the Examiner's arguments and even amend the claims further, if desired, to address what is much more of a basis of the argument set forth by the Examiner. Because the MPEP suggests that providing Applicant with a fair opportunity to reply on issues of concern, Applicant respectfully requests that the final status of this Official Action be withdrawn for this reason as well.

Further, Applicant responds herein to the arguments made by the Examiner in paragraphs 2-5 and 8 of the final Official Action and has amended Claims 1-6 and 10-13, but respectfully submits that such arguments and amendments are made without prejudice as to removal of the final status of the Official Action as set forth above and without prejudice as to equivalents or other patentability issues. In the Official Action, Applicant respectfully submits that in addition to not setting forth a prima facie showing of obviousness as set forth above, the Examiner has failed to set forth a prima facie showing of obviousness as not having provided any evidence of motivation for making the combinations. For example, this requirement requires that the Examiner provide evidence of motivation to combine, including with respect to the claims amended in the last response. Having not done this, Applicant respectfully submits that this final status is not proper and even if it were proper the evidence is not sufficient as required. Applicant respectfully submits that the Examiner argues what the combined teachings suggests, but simply says that they related to silicon carbide. Applicant respectfully submits that this is neither the test nor proper. Applicant's characterization about the Nagle et al. patent being related to formation of charcoal is correct. Applicant believes that the teaching of the Nagle et al. patent is directed to making more effective charcoal. With all respect, the Examiner appears to be dodging what the patent teaches as a whole. Silicon carbon is used to make many items known to those skilled in the art from semiconductors to charcoal. Applicant respectfully submits that the fact that silicon carbide is used to make charcoal places the Nagle et al. patent into the proper context of why one skilled in the art would have no motivation to combine the Nagle et al. patent with the Nilson et al. patent to somehow in hindsight arrive at the claimed

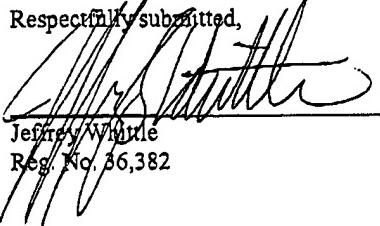
In re Patent Application of  
Gardner

Serial No. 10/044,738

invention. Again, with all respect, why would someone who wanted to make a better preform such as used for molding items therefrom be motivated by art related to forming charcoal such as taught in Nagle et al. with art related to forming particle boards? The law and the MPEP require that the Examiner take these patents for what they teach as a whole, and the Examiner has not properly done so. The Examiner suggests that Applicant cannot show nonobviousness by attacking the references individually, but Applicant respectfully submits that the attacks on the references individually are allowed when showing that one skilled in the art would have no motivation to combine the patents. In other words, as suggested in *In re Kotzab*, as well as many other cases cited in the MPEP, one of the places to support motivation to combine is from the patents themselves. So, what Applicant is pointing out to the Examiner is that the patent documents themselves provide no motivation to combine and that any motivation set forth by the Examiner is obtained by improper hindsight is selecting pieces of Nagle et al. which teaches how to form better charcoal with pieces from Nilson et al. which teaches how to form better particle board. With all respect, neither the teachings when taken as a whole would arrive at the claimed invention nor would one skilled in the art even have any motivation to make such a combination. Therefore, Applicant respectfully submits that Claims 1-13 are nonobvious and also define over the cited patents as well.

#### CONCLUSION

In view of the amendments and remarks set forth herein, Applicants respectfully submit that the application is in condition for allowance. Accordingly, the issuance of a Notice of Allowance in due course is respectfully requested.

Respectfully submitted,  
  
Jeffrey Whittle  
Reg. No. 36,382

Date: May 5, 2003

BRACEWELL & PATTERSON, L.L.P.  
P.O. Box 61389  
Houston, Texas 77208-1389  
Telephone: (713) 221-1185

1549238v1